



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIN 50-09

CLEON L. GRIFFITHS
10080 WEST 8TH PLACE
LAKEWOOD CO 80215

COPY MAILED

MAR 19 2009

In re Application of : **OFFICE OF PETITIONS**
Cleon Louis Griffiths :
Application Number: 09/825483 : ON PETITION
Filing Date: 04/03/2001 :
For: SECURE CONDOM :
:

This is a decision on the paper filed on March 10, 2009, which, is treated as a renewed petition under 37 CFR 1.137(a),¹ to revive the above-identified application.

The petition is again **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or as discussed below "Renewed Petition under 37 CFR 1.137(b)."

The application became abandoned on November 23, 2002, for failure to timely file a proper response to the Office action stating that the prior reply appeared to be a *bona fide* attempt

¹ A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(l);

(3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

at a reply, but was insufficient, which set a one (1) month shortened statutory period for reply. A response was received on March 18, 2003, but was untimely. On November 5, 2003, an Office letter was mailed stating that the reply filed on March 18, 2003, was untimely, and that extensions of time were required. On November 18, 2003, Notice of Abandonment was mailed. A petition under 37 CFR 1.137(a) was filed on December 17, 2007. On January 18, 2008, the petition was dismissed.

On March 10, 2009, the subject letter was filed, addressed to the undersigned Petitions Attorney, whereby petitioner *pro se* states that he wishes to provide additional information concerning the circumstances at the time the application was filed.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".² Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

² 35 U.S.C. § 133.

³ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).⁴ Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁴

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(a):

- (1) The delay in reply that originally resulted in abandonment;
- (2) The delay in filing an initial petition pursuant to § 1.137(a) to revive the application; and
- (3) The delay in filing a grantable petition pursuant to § 1.137(a) to revive the application.⁵

This petition lacks the showing required by periods (1), (2) and (3).

With regards to items (1) and (2), petitioner has provided no basis supporting a showing of unavoidable delay. The statements in the petition again appear to be simply petitioner's interpretation of communications with the examiner and an argument as to why the invention is patentable.

As petitioner has provided no basis for a showing of unavoidable delay, the petition must be dismissed.

Petitioner may wish to consider utilizing the services of a registered patent attorney or agent. The USPTO cannot recommend any particular attorney or agent, or aid in the selection of an attorney or agent, as by stating, in response to inquiry that a named patent attorney, agent, or firm, is "reliable" or "capable." The USPTO maintains a directory of registered patent attorneys and agents at <https://oedci.uspto.gov/OEDCI/>.

⁴ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁵ See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

Petitioner may also receive further information by calling the Inventor's Assistance Center at 1-800-PTO-9199.

With regards to item (3), petitioner was informed in the decision mailed on January 18, 2008, that any request for reconsideration must be filed within two (2) months from the mail date of the decision, and that extensions of time were available under 37 CFR 1.136(a). The subject paper requesting reconsideration was filed on March 10, 2009, over one (1) year after the decision was mailed on January 18, 2008, and after the expiration of the extendable period for reply to the aforementioned decision on petition.

As such, petitioner must explain why the subject renewed petition should not be dismissed out of hand for being untimely. In future filings, petitioner should ensure that any renewed petition is filed within the time period for reply set forth in the decision on petition or other Office communication.

Further, any renewed petition under 37 CFR 1.137(a) must provide a documented showing as to why the entire delay, from the date a reply to the Office action mailed on October 22, 2002, until the date a grantable petition was filed, is unavoidable.

As petitioner has provided no explanation of the extended period of delay in filing a renewed petition, the petition must be dismissed.

ALTERNATIVE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after 8 June, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be

the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Should petitioners decide to file a petition under 37 CFR 1.137(b), the additional petition fee due would be \$810.00 for a small entity.

A copy of the form for filing a petition under 37 CFR 1.137(b) is enclosed for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: PTO/SB/64